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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/634,336 | 08/04/2003 | Kyle R. Gee | | 6767 |
| 23358 | 7590 | 07/25/2005 | EXAMINER | |
| KOREN ANDERSON MOLECULAR PROBES, INC. 29851 WILLOW CREEK ROAD EUGENE, OR 97402-9132 | | | | KIFLE, BRUCK |
| | | ART UNIT | | PAPER NUMBER |
| | | 1624 | | |

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/634,336 | GEE ET AL. |
| | Examiner | Art Unit |
| | Bruck Kifle, Ph.D. | 1624 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 July 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 28-38 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

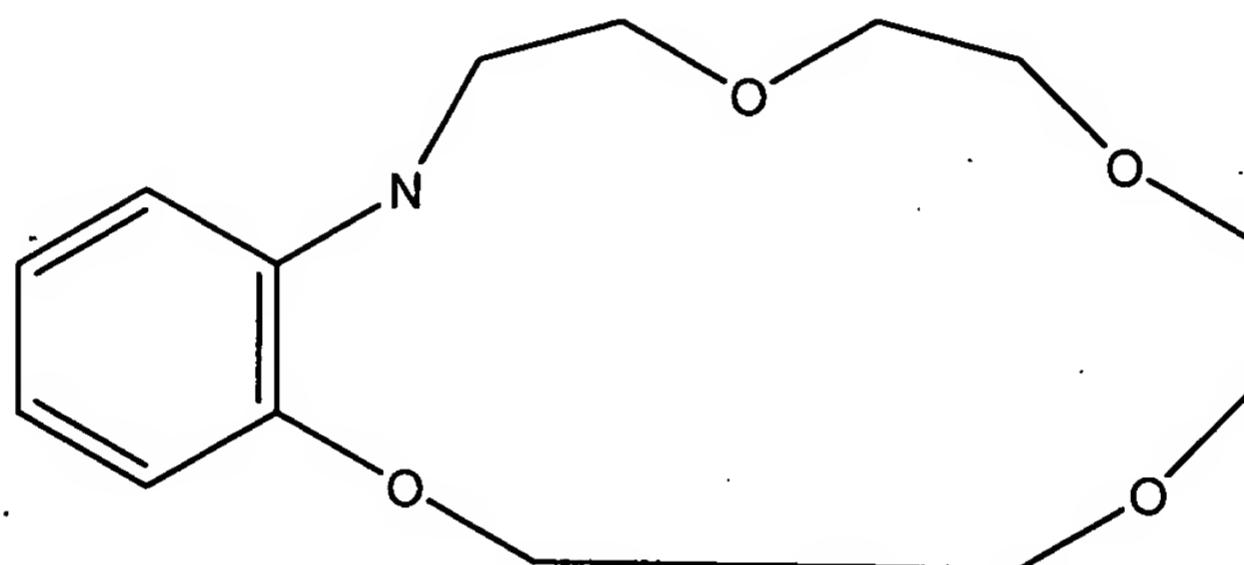
Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 11/04/03.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Election/Restrictions

Applicant's election of the compound 86 on pages 96-97 in the reply filed on 07/17/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The elected compound was not found in the search and is allowable. The search has been expanded to embrace the core



Compounds embraced by this core are under consideration. The search did not extend to compounds wherein Sc is as defined in claims 8 and 9 because these biomolecules require separate searches. Should Applicants maintain these groups, a restriction requirement will be made to elect a specific Sc group.

Claims 28-38 (along with subject matter not falling under the above core) are withdrawn from consideration because they are drawn to compositions, methods and kits that raise different issues of patentability and require separate searches.

Claim Rejections - 35 USC § 112

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) The group R_X is defined as "a reactive group." This is indefinite because a "reactive group" depends on the reaction condition and changes definition depending on where it is used.

Applicants are requested to insert the actual groups intended. The groups at claims 6 and 7 need to be presented as radicals and not as classes of compounds.

ii) The group S_C is defined as a "conjugated substance." One skilled in the art cannot say what the metes and bounds of this group are.

iii) The group DYE is defined as "a reporter molecule." This is manifestly indefinite because one skilled in the art cannot say what this is. First, a molecule does not have an open valency to bond as a radical to the rest of the macrocycle. Secondly, it is not known what is and is not a reporter molecule. The compounds at claim 10 cannot be radicals because they do not have a point of attachment. Appropriate correction is required.

Information Disclosure Statement

The information disclosure statement filed 11/04/03 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The references C1-C5 are not present in this case or the parent application. A line has been drawn through these citations.

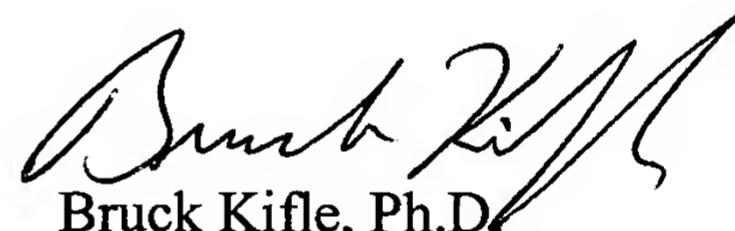
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 571-272-0668.

The examiner can normally be reached Tuesdays to Fridays between 8:30 AM and 6:00 PM.

Art Unit: 1624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bruck Kifle, Ph.D.
Primary Examiner
Art Unit 1624

BK

July 21, 2005